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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SCHNEIDER, JOSHUA D

ART UNIT

PAPER NUMBER

2182

6

DATE MAILED: 05/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PPE

Office Action Summary	Application No.	Applicant(s)	
	09/834,025	KUBOTA, YOSHIYASU	
	Examiner	Art Unit	
	Joshua D Schneider	2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 2, and 6 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. With regards to claims 1 and 6, the term “performing setting” does not distinguish what is the intended method step. An artisan would not be able to perform setting without more definition of the method. With regards to claim 2, the term “function of a memory” does not distinguish what is the intended function. An artisan would not be able to perform the “function of a memory” without more definition of the method.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regards to claim 7, it is unclear how a list of codes of functions and code associated therewith are included in an address. This appears to be a literal translation into English from a foreign document, which intends to cite a list of functions at a predetermined address.

7. All further rejections and objections are made in light of the specification as best understood in view of the previous objections and rejections.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,901,303 to Chew. With regards to claims 1 and 6, Chew teaches providing a removably connected electronic device (in this case a smart card), having a register (memory), having a write area and a read area (Fig.1, and column 4, lines 53-64). The card performs startup processes and then receives a command from the main unit (reader, column 6, lines 14-21). Chew does not explicitly distinguish a read and a write area of a register. However, it would have been obvious to one of ordinary skill in the art at the time of invention that the RAM memory acts as a writing area when the card receives commands for processing, and that the

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reading area could be embodied in either data buffered in the RAM or data in either ROM or programmable memory.

10. It is inherent to Chew that the requested function is written into the write area of the register (RAM) when the command is processed (column 6, lines 19-21). Chew then teaches the reading of a code of a function (column 6, lines 19-21 and 26-27, and column 4, line 63, though column 5, line 5), and a code associated therewith (column 5, lines 5-12).

11. With regards to claims 2 and 7, Chew teaches a list of codes of the functions (column 6, lines 19-21), and a code associated therewith (column 5, lines 5-12). Chew does not explicitly teach the list being at a predetermined address. It would have been obvious to one of ordinary skill in the art at the time of invention that the list of codes of the functions would have to have been at a predetermined address for it to be accessed by the operating system (column 6, lines 19-21).

12. With regards to claims 3 and 8, Chew teaches the determination of a function to be executed after accessing the list at the predetermined address (column 6, lines 19-21 and 26-27).

13. With regards to claims 4 and 9, Chew teaches the determination of a function to be executed after accessing the list at the predetermined address (column 6, lines 19-21 and 26-27). Chew teaches a list of codes of the functions (column 6, lines 19-21), and a code associated therewith (column 5, lines 5-12). Chew does not explicitly teach the list being at a predetermined address. It would have been obvious to one of ordinary skill in the art at the time of invention that the list of codes of the functions would have to have been at a predetermined address for it to be accessed by the operating system (column 6, lines 19-21).

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14. With regards to claims 5 and 10, Chew teaches the enablement of the execution of a function after the determination (column 6, lines 26-27).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Schneider whose telephone number is (703) 305-7991. The examiner can normally be reached on M-F, 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A Gaffin can be reached on (703) 308-3301. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

JDS
May 5, 2003


JEFFREY GAFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100